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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,887	10/22/2003	John P. Finley	8471-0001CPA	6832
27572	7590	12/16/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			COLE, LAURA C	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,887

Applicant(s)

FINLEY, JOHN P.

Examiner

Laura C Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 10 is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10222003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a shoe cleaning apparatus, classified in class 15, subclass 159.1.
 - II. Claims 11-14, drawn to a method of moving a shoe cleaning apparatus, classified in class 15, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of moving a shoe cleaning apparatus can be used for a cleaning apparatus having a single brush unit and the cleaning apparatus may have more than one brush unit, is not required to have an operating or storage positions, a hitch receiving portion, or a mounting aperture.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Brian Hollis on 02 December 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "330" and "354" (Figure 6). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 does not provide additional structure in the claim, only a process of use.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hensley, USPN 3,142,853.

Hensley discloses the claimed invention including a shoe cleaning apparatus that comprises a frame (44) having a forward end including a mounting arm (42, 10), at least one brush unit coupled to the frame (46), a coupling element (26) coupling a second end of the mounting arm of the frame to the hitch receiver (S) of the vehicle (C; Column 2 Lines 3-7; see Figure 1), and a hinge disposed on the mounting arm (54, 56) that is capable of moving the brush unit between two positions (see Figure 2 and Figure 7). The mounting arm includes at least one mounting aperture formed thereon (22). The coupling element (26) extends through the mounting aperture (22; see Figure 4). The mounting arm includes a stepped portion (at 42, see Figures 1, 2, 4, and 5) that

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presents the frame in a laterally offset relationship from the hitch receiver (see Figure 1). The mounting arm includes an upper portion (10) coupled to the hitch receiver (S) and a lower portion (42) laterally offset from the upper portion toward a ground surface (at 42, see Figures 1, 2, 4, and 5), the lower portion coupled to the brush assembly (see Figure 4). The "hinge" is both disposed on the upper portion and lower portion of the mounting arm.

5. Claims 1, 2, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Racina, USPN 3,028,617.

Racina discloses the claimed invention including a shoe cleaning apparatus that comprises a frame (10) having a forward end including a mounting arm (3, 4), at least one brush unit coupled to the frame (10', 10a), a coupling element (8) coupling the second end of the mounting arm of the frame to the hitch receiver (2), and a hinge (5) disposed on the mounting arm for moving the brush between an operating position and storage position (see Figure 2). The mounting arm includes at least one mounting aperture (9). The coupling element extends through the mounting aperture (see Figures 2-3).

6. Claims 1, 2, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodward, USPN 6,363,567.

Woodward discloses the claimed invention including a shoe cleaning apparatus that comprises a frame (18a, 18b) having a forward end including a mounting arm (13a, 13b), at least one brush unit coupled to the frame (17), a coupling element (21, 23) coupling the second end of the mounting arm of the frame to the hitch receiver (12), and

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a hinge (19, a "hinge" is defined as "A jointed or flexible device that allows the turning or pivoting of a part" by *The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company*) disposed on the mounting arm for moving the brush between an operating position and storage position (see Figures 1-2). The mounting arm includes at least one mounting aperture (in that 13a and 13b are "channels", Column 2 Lines 46-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Hensley, USPN 3,142,853.

Hensley discloses all elements above including a stepped portion (at 42) that is at 45 degrees (Column 2 Lines 34-36), however does not disclose that the stepped portion extends perpendicularly between the upper portion and lower portion.

At the time the invention was made, it would have been obvious for one of ordinary skill in the art to modify the stepped portion of Hensley to extend perpendicularly rather than at 45 degrees since the Applicant has not disclosed that having a stepped portion extend perpendicularly provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with the stepped portion of a mounting arm because it adjusts the height and position of the brush assembly at an appropriate angle for cleaning the soles of shoes.

Allowable Subject Matter

8. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: None of the prior art made of record includes a shoe cleaning apparatus including the combination of a frame, brush unit, a coupling element, hinge, a mounting arm having at least one mounting aperture, and wherein the coupling element extends through said hitch receiver aperture *and* said mounting aperture. Also, none of the prior art made of record includes a linking aperture formed on a rearward end thereof with the linking aperture adapted to cooperate with a tow bar in a towing position.

USPN 2,857,173 to Benander displays a shoe scraper wherein the frame includes a linking aperture on a rearward end for linking a second brush assembly (see Figures).

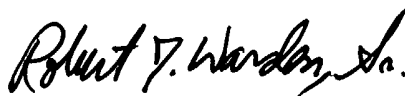
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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06 December 2004


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